



Xerox Docket No.: D/A1029

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Peter M. GULVIN

Group Art Unit: 2853

Application No.: 09/682,895

Examiner: D. Sorkin

Filed: October 30, 2001

Docket No.: 109177

For: INTEGRATED MICROMACHINED FILTER SYSTEMS AND METHODS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

In reply to the April 18, 2003 Restriction Requirement, Applicant provisionally elects Group I, claims 1-17 and 18-24, with traverse.

The Office Action asserts that the product of Group I and the process of Group II are distinct because "the product could be used at or to cover an inlet, rather than downstream of an inlet." This reasoning does not apply to all of the claims of Group I.

Applicant notes that independent claim 11 of Group I recites a micromachined filter that is integrated in the micro-device downstream of the fluid inlet. Applicant also notes that claim 9 of Group I recites that the micromachined filter is situated downstream of a fluid inlet through the substrate. Thus, the product of these claims of Group I cannot "be used at or to cover an inlet, rather than downstream of an inlet" as asserted by the Office Action.

Independent claim 25 of Group II recites the steps of passing a fluid through a fluid inlet of a micro-device and passing the fluid through a filter that is integrated in the micro-device downstream of the fluid inlet. Thus, the search for the subject matter of the claims of

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Group II would necessarily encompass the search of the subject matter of at least some, if not all, of the claims of Group I.

The Office Action asserts that the product of Group I can be made by another and materially different process than the process of Group III. This does not apply to all of the claims of Group I.

The Office Action incorrectly asserts that "the filter could be made by more directly etching the substrate." Independent claim 1 of Group I recites a micromachined filter integrated in at least one of a plurality of micromachined layers formed over a substrate. This claimed structure cannot be formed by etching the substrate as asserted by the Office Action.

Independent claim 30 of Group III recites a method for manufacturing a micro-device having an integrated filter. The Office Action has not established that a materially different process can be used to make product of Group I. Thus, the search for the subject matter of the claims of Group III would necessarily encompass the search of the subject matter of at least some, if not all, of the claims of Group I.

The Office Action asserts that the processes of Groups II and III are distinct from one another because the processes are distinct from the product of Group I. This reasoning is logically flawed because the conclusion does not follow from the premise. For example, the processes could differ from the product in the exact same way, while not differing from one another. Furthermore, as discussed above, the premise is not true - the processes are not distinct from the product as required for a proper restriction.

For at least the foregoing reasons, it is respectfully submitted that the subject matter of all claims 1-32 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that

"if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



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Date: May 19, 2003

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